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MAILED
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OFFICE OF PETITIONS

In re Patent No. 6,010,468 :
Issued: January 4, 2000 : ON PETITION
Application No. 09/035,136 :
Filed: March 5, 1998 :
For: FOOT FLEXION DEVICE :

This is in response to the petition under 37 CFR 1.378(b), filed July 10, 2012, to accept the unavoidably delayed payment of the maintenance fee for the above-identified patent.¹

The patent issued January 4, 2000. The grace period for paying the second maintenance fee expired on January 5, 2008.

The Director may accept the payment of any maintenance fee due on a patent after expiration of the patent if, upon petition, the delay in payment of the maintenance fee is shown to the satisfaction of the Director to have been unavoidable and if the surcharge required by § 1.20(i)(1) is paid as a condition of accepting payment of the maintenance fee. 37 CFR 1.378(a).

A petition under 37 CFR 1.378(b) to accept late payment of a maintenance fee must include:

- (1) the required maintenance fee set forth in § 1.20(e) through (g);
- (2) the surcharge set forth in § 1.20(i)(1); and
- (3) a showing that the delay was unavoidable since reasonable care was taken to ensure that the maintenance fee would be paid timely and that the petition was filed promptly after the patentee was notified of, or otherwise became aware of, the expiration of the patent.

The required showing must enumerate the steps taken to ensure timely payment of the maintenance fee, the date and the manner in which patentee became aware of the expiration of the patent, and the steps taken to file the petition promptly.

¹ The Office notes that the patent expired for failure to pay both the second and third maintenance fees.

Furthermore, an adequate showing requires a statement by all persons with direct knowledge of the cause of the delay, setting forth the facts as they know them. Copies of all documentary evidence referred to in a statement should be furnished as exhibits to the statement.

The USPTO finance records reveal that petitioner did not submit the requisite maintenance fee and surcharge with the present petition. The current small entity amount for the maintenance fee due at 7.5 years as set forth in 37 CFR 1.20(f) is \$1,425.00. Additionally, the current amount for the surcharge after expiration where the late payment is unavoidable as set forth in 37 CFR 1.20(i)(1) is \$700.00. As these fees have not been paid, the petition will not be treated on the merits until petitioner submits a "renewed" petition under 37 CFR 1.378(b), accompanied by the payment of the \$1,450.00 maintenance fee and the surcharge in the amount of \$700.00. Thus, the petition is dismissed. The proper petition form is enclosed for petitioner's convenience. Petitioner must submit the maintenance fee and surcharge in the amount due on the date the "renewed" petition is filed and the maintenance fee and surcharge are paid.

Although the Office will not address the petition on its merits at this time, the Office reminds petitioner that where the record fails to disclose that the patentee took reasonable steps, or discloses that the patentee took no steps, to ensure timely payment of the maintenance fee, 35 U.S.C. 41(c) and 37 CFR 1.378(b)(3) preclude acceptance of the delayed payment of the maintenance fee under 37 CFR 1.378(b). Additionally, a patentee's preoccupation with other matters that may have taken precedence over timely payment of the maintenance fee does not constitute unavoidable delay. See Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982).

If The Discovery Group was responsible for the payment of the second and third maintenance fees, petitioner must provide a statement from a person with firsthand knowledge of events (e.g. a member of The Discovery Group) describing the reasonable steps taken to ensure the timely payment of the maintenance fees. Documentary evidence in support of the statement should be submitted on "renewed" petition.

The Office notes that petitioner is bound by the delay resulting from the decisions, actions, or inactions of The Discovery Group, their shareholders or members, including those business decisions, actions, or inactions that led to the failure to obtain or remit the maintenance fee. See Winkler v. Ladd, 221 F.Supp. 550, 552, 138 USPQ 666, 667 (D.D.C. 1963). Moreover, it is immaterial to the delay that led to the expiration that petitioner would not have acquiesced to the actions or inactions of The Discovery Group. See Kim v. Quigg, 718 F.Supp. 1280, 12 USPQ2d 1604 (E.D. Va 1989). Any delay caused by The Discovery Group, the party in interest at the time the maintenance fee was due, is binding on petitioner as the successor in title. See Winkler v. Ladd, 221 F.Supp. 550, 552, 138 USPQ 666, 667 (D.D.C. 1963).

It is noted the address given on the petition differs from the address of record; however, there is no indication in the patent file that petitioner filed a change of address in this case. If the petitioner desires to receive future correspondence regarding this patent, the appropriate change

of correspondence address must be submitted. The appropriate form is enclosed. As a one-time courtesy, the Office will mail a copy of this communication to petitioner. Thereafter, the Office will continue to send correspondence to the address of record until otherwise notified.

The application file is being forwarded to Files Repository.

Inquiries concerning this matter may be directed to the undersigned at (571) 272-3211.

/Christina Tartera Donnell/

Christina Tartera Donnell
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Enclosures: Petition to Accept Unavoidably Delayed Payment of Maintenance Fee in an Expired Patent and Change of Correspondence Address

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